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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,413	02/20/2001	Hiroshi Tanaka	FJ-2000-043-US	1891

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EXAMINER
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MISLEH, JUSTIN P

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/785,413	Applicant(s) TANAKA ET AL.	
	Examiner Justin P. Misleh	Art Unit 2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 - 98 is/are pending in the application.
- 4a) Of the above claim(s) 1 - 50 and 89 - 98 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51 - 88 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Claims 51 – 88 in the reply filed on November 30, 2005 is acknowledged.

### *Specification*

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### *Drawings*

3. The drawings are objected to because of minor typographical errors.

**Figure 14** – Steps S100 and S102 contain spelling errors. Steps S100 and S102 should recite, “SET TO COMMUNICATION MODE” and “SET TO IMAGE OBTAINING MODE”, respectively.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: **Step S110** (page 33, line 4).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing

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should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

5. **Claim 51** is objected to because of the following informalities: inconsistent claim language.

The claim recites, *inter alia*, “the information of directories in which the file name of functions”, however no “information of directories” and no “file names of functions” have been previously introduced. Furthermore, the claim additionally recites therein, “the function file names”.

For the purposes of clarity, the Examiner recommends changing “the information of directories in which the file name of functions” to “information of directories in which function file names”.

**Appropriate correction is required.**

*Claim Rejections - 35 USC § 112*

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. **Claims 51 – 88** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claims require therein, a selecting device for selecting “a desired function file name showing a desired function” on the basis of the displayed directories which have been passed from an information processing device to an image information receiver through a communication device, wherein the directories have function files with corresponding function file names registered therein “indicating at least a function for picking up an image,” further wherein “the function file names are classified under at least one of parameters indicating image pick-up conditions and parameters indicating the properties of an image to be transmitted to the image information receiver through the communicating device.”

However, Applicant is reminded “the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” (emphasis added) (see MPEP §2164.01)

In this case, one reasonably skilled in the art could not make or would know how to use, based upon the disclosure coupled with information known in the art, an information processing

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device having a memory with a root directory structure that registers function files names corresponding to function files such that each function file indicates a function for picking up an image, wherein the function file names are classified under parameters indicating image pick-up conditions and properties of an image to be transmitted to the image information receiver.

According to page 24 (lines 23) – page 27 (line 21) and page 34 (lines 14 – 27) of specification, function files are given names similar to image files (e.g., shoot.jpg and lastshot.jpg) and correspond to a function the camera is supposed to perform when such a file is selected. However, in the above sections of the specification, there was no indication as how the function files are generated or how the actual information stored in such a file causes the image pickup device to perform certain operations. For instance, there is no indication as to the relationship between the other JPEG compressed image files (e.g., Dscf0001.jpg) and the function files and certainly no indication as to the relationship between typical camera commands (e.g., from the shutter button 20) and the function files. An adequate disclosure of such an information processing device should detail all necessary components, features, and methods required for generating and using the function files as recited in the claims. (see MPEP §2164.06(a))

#### *Cited Prior Art*

8. The prior art made of record (see attached form PTO-892) and not relied upon is considered pertinent to Applicant's disclosure for the reason each discloses therein:

A system for transmitting image information from a camera to computer, wherein the computer at least has some indication as to the contents of the camera memory, further wherein

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the camera memory stores images under a root directory in a hierarchical structure. A portion of the cited prior art at least discloses the computer requesting image information from the camera and the computer instructing image capture by the camera.

*Conclusion*

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Justin P Misleh whose telephone number is 571.272.7313. The Examiner can normally be reached on Monday through Friday from 8:00 AM to 5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, David L Ometz can be reached on 571.272.7593. The fax phone number for the organization where this application or proceeding is assigned is 571.273.3000.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JPM  
March 6, 2006



DAVID OMETZ  
SUPERVISORY PATENT EXAMINER